

REMARKS/ARGUMENTS

Claims Status / Support for Amendments

Claims 1, 3-10 and 12-23 are pending. Claims 1, 3, 4, 6-10, 12, 13 and 15-19 remain as previously presented. Claims 2 and 11 were previously canceled without prejudice. Claims 5 and 14 are currently amended to include subject matter from page 32, lines 4-9 of the specification. Claims 20-23 are added. Claims 20 and 21 find support at page 32, lines 4-9 of the specification. Claims 22 and 23 find support at page 4, lines 4-10 of the specification. No new matter has been entered.

§103(a) Rejection

Claims 1, 3-10 and 12-19 are rejected as obvious over the combination of Masashi (AU-B-25757/95) and Nambu (US 7,732,050), or over the combination of Masashi and Modi (US 6,905,694). Applicants respectfully traverse these rejections.

A. At the outset, Applicant notes that Nambu qualifies as prior art *only* under 35 U.S.C. §102(e). Accordingly, as Nambu is only 102(e) art, the obviousness rejection relying upon Nambu is deficient under 35 U.S.C. §103(c) as explained below.

Common Ownership Statement

Applicants submit that the present application and the Nambu reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to Kao Corporation. Accordingly, application of the Nambu reference in an obviousness rejection is improper.¹

Thus, Applicants submit that the obviousness rejection over the combination of Masashi and Nambu is effectively traversed since Nambu may not be applied as a basis for supporting a *prima facie* case of obviousness as outlined by 35 U.S.C. §103(c). Accordingly,

¹ Applicant notes that the filing date of the present application is after November 29, 1999, therefore bringing the present application under the current guidelines for 35 U.S.C. §103(c) for excluding 102(e) art.

Applicants respectfully request withdrawal of the obviousness rejection over the combination of Masashi and Nambu.

B. Regarding the combination of Masashi and Modi, Applicants provide the following remarks. At the outset, Applicants note that the Office has relied upon Modi merely for its alleged disclosure of personal care compositions comprising hydrophobically modified water soluble polysaccharide polymer(s) wherein such compositions are in the form of *oil-in-water* or water-in-oil emulsions (noting that independent claims 1 and 10 recite that the claimed emulsified cosmetic composition is an oil-in-water emulsion). As such, the focus of the remaining remarks will be with respect to Masashi (i.e., the claim limitations *not* drawn toward the emulsion type).

Independent claims 1 and 10 of the present application recite that “the *average* particle diameter of said surface-hydrophobated water-absorbing polymer particles is 0.1 to 10 μm ” (italics emphasis added).

In contrast, Masashi discloses:

“As to the particle size distribution of the water-absorbent resins (A), it is necessary to use water-absorbent resin particles with the particle size distribution having 95 weight % or more of particles with the size of 10 - 1,000 μm , preferably water-absorbent resin particles with the particle size distribution having 95 weight % or more of particles with the size of 50 - 850 μm among (A) particles. Since water-absorbent resin particles with the particle size distribution having less than 95 weight % of particles with the size of 10 - 1,000 μm containing much particles having a smaller particle size tend to form lumps at the time of water absorption to deteriorate the adsorption rate, it is not preferable.” (underline and italics emphasis added)

Accordingly, given Masashi’s above-quoted disclosure, as well as Applicants’ claimed average particle diameter being an *average* diameter, Applicants submit that **it is *not* accurate to say that the claimed polymer particles having an average particle diameter of 0.1 to 10 μm includes/reads on “95 weight % or more of particles with the size of 10 - 1,000 μm ” as recited by Masashi.**

Furthermore, one skilled in the art would conclude that Masashi discloses a “preferred” working particle size distribution having 95 weight % or more of particles with the size of 50 - 850 μm . Therefore, one skilled in the art would have no motivation to look to particle size distributions having 95 weight % or more of particles with a size below 10 μm , or preferably below 50 μm . Moreover, courts have held that where, as here, the prior art disclosure suggests the outer limits of the range of suitable values, and that the optimum resides within that range, and where there are indications elsewhere that in fact the optimum should be sought within that range, the determination of optimum values outside that range may not be obvious (*In re Sebek*, 465 F.2d 902, 175 USPQ 93, 95 (CCPA 1972)). Thus, without any motivation to consider particle size distributions having 95 weight % or more of particles with a size below 10 μm , or preferably below 50 μm , Applicants’ claimed average particle diameter of the surface-hydrophobated water-absorbing polymer particles being 0.1-10 μm (see claims 1 and 10), or being 0.1 to 5 μm (see claims 22 and 23) is not rendered obvious by Masashi. Accordingly, Applicants’ claims are *not* rendered obvious by Masashi.

In addition, Applicants point out claims 5 and 14 that currently recite “the content of water [of the emulsified cosmetic composition] is 30 to 95% by weight.” In contrast, Masashi merely discloses water-absorbent resin particles, not an “emulsified cosmetic composition” comprising such particles, like claimed. Furthermore, Applicants submit that incorporation of 30-95 wt% of water with the particles of Masashi would be contrary to the nature/goal of Masashi for at least the following reasons.

Masashi discloses that the water-absorbent resin particles of Masashi’s invention have certain properties, those properties include (a) a hygroscopic blocking rate (i.e., percentage of particles that have met their blocking point) in high humidity that is “in general, 20% or less, preferably 10% or less,” and (b) an “initial absorbency under load to physiological saline solution [that] is 20 g/g or more, preferably 25 g/g or more” wherein “physiological saline

solution herein denotes an aqueous solution of sodium chloride (concentration of 0.85 - 0.95 weight %)” (see page 21 of Masashi).

Accordingly, Applicants submit that incorporation of 30-95 wt% of water with the particles of Masashi would destroy (a) the 20% or less hygroscopic blocking rate feature of Masashi’s particles, *and* would destroy (b) the 20 g/g or more initial absorbency feature of Masashi’s particles. Thus, in light of MPEP 2143.01, Part V which states “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984),” and Part VI which states “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959),” Applicants submit that Masashi is not sufficient to render the claims *prima facie* obvious.

Lastly, given that Modi is relied upon merely for its alleged disclosure of personal care compositions comprising hydrophobically modified water soluble polysaccharide polymer(s) wherein such compositions are in the form of an *oil-in-water* emulsion (see above), Applicants submit that Modi does not fulfill the above-discussed deficiencies of Masashi. Accordingly, the combination of Modi with Masashi fails to render obvious the claimed invention for the same reasons that Masashi alone fails to render obvious the claimed invention. Thus, Applicants respectfully request withdrawal of the obviousness rejection of record over the combination of Masashi and Modi.

Non-Statutory Obviousness-Type Double Patenting Rejection

Claims 1, 3-10 and 12-19 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of Nambu (US 7,732,050) in view of Masashi and Modi. Applicants respectfully traverse this rejection.

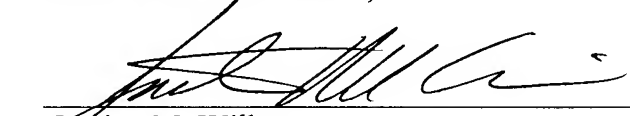
Applicants note that the Office's basis for this rejection is the same as the obviousness rejections under 35 U.S.C. §103(a) already discussed above. Applicants also note that traversals of §103(a) obviousness rejections equally apply to non-statutory obviousness-type double patenting rejections. Accordingly, Applicants herein incorporate by reference the above traversal regarding the combination of Masashi and Modi. As such, Applicants respectfully request withdrawal of this rejection for the same reasons noted above regarding the obviousness rejections over the same references.

Conclusion

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Justine M. Wilbur
Attorney of Record
Registration No. 59,678

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)